

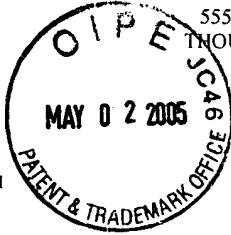
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May 2, 2005

Mail Stop PETITION
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Attention: Ms. Marianne E. Jenkins
Petitions Examiner

Re: Applicant: Andrew R. Searle, et al
Serial No.: 09/582,796
Filed: August 23, 2000
Docket No.: 584-26-002 (938-26-005)

Dear Ms. Jenkins:

On April 11, 2005 you issued a denial of our Petition to Revive the above-referenced application. In a telephone conversation on April 15, 2005, you indicated that we had two months from the date of the opinion to file a proper response and an RCE but the grant of that two-month extension was not indicated in the Petition denial.

We have now filed that RCE in reliance on our telephone conversation. It would be greatly appreciated if you would provide us with a supplement to the April 11, 2005 decision verifying that two-month extension so that we have a written record in support of that two-month extension.

Very truly yours,
KOPPEL, JACOBS, PATRICK & HEYBL

Michael J. Ram
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Attorney for Applicants

MJR/en
E/M/N/584-26-002.LtrPetitionsExaminer
Enclosure

Serial No. : 09/582,796
Applicant: Andrew R. Searle, et al
Docket No.: 584-26-002 (938-26-005)



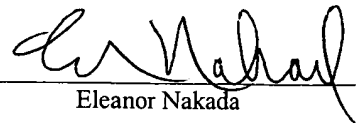
May 2, 2005

CERTIFICATE OF EXPRESS MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service, Express Mail Label EV460260030US, in an envelope addressed to: Mail Stop Petition, Attn. Marianne E. Jenkins, Commissioner of Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

5-2-05

Date


Eleanor Nakada



UNITED STATES PATENT AND TRADEMARK OFFICE

584-26-002

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APR 11 2005

OFFICE OF PETITIONS

In re Application of
Andrew R. Searle, et al.
Application No. 09/582,796
Filed: August 23, 2000
Attorney Docket No. 938 26 005

ON PETITION

This is a decision on the petition under 37 CFR 1.137(a), or in the alternative, 37 CFR 1.137(b), filed December 8, 2004, to revive the above-identified application.

The petition under 37 CFR 1.137(a) is **DISMISSED**.

The petition under 37 CFR 1.137(b) is **DISMISSED**.

A grantable petition under 37 CFR 1.137(a) must be accompanied by: (1) the required reply, unless previously filed;¹ (2) the petition fee as set forth in 37 CFR 1.17(l); (3) a showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(a) was unavoidable; and (4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required pursuant to 37 CFR 1.137(c). The instant petition lacks items (1) and (3).

A final Office action was mailed to applicant on June 7, 2004, which set a three (3) month shortened statutory period for reply. Since no reply was received and no extensions of time under the provisions of 37 CFR 1.136 were obtained, the application became abandoned on September 8, 2004.

With regard to item (1):

The proposed reply required for consideration of a petition to revive must be a Notice of Appeal (and appeal fee required by 37 CFR 1.17(b)), an amendment that *prima facie* places the application in

¹ In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof.

CALENDAR ENTRY

ACTION Response Due
CALENDAR FOR 6/11/05

condition for allowance, a request for continued examination (RCE) under 37 CFR 1.114, or the filing of a continuing application. See MPEP 711.03(c)(III)(A)(2). **Since the amendment submitted does not *prima facie* place the application in condition for allowance, the reply required must be a Notice of Appeal (and appeal fee), a request for continued examination under 37 CFR 1.114, or the filing of a continuing application.** A copy of the Examiner's Advisory Action is attached herewith.

With regard to item (3):

The showing of record is not sufficient to establish to the satisfaction of the Commissioner that the delay was unavoidable within the meaning of 35 U.S.C. § 133 and 37 CFR 1.137(a). See MPEP 711(c)(III)(C)(2) for a discussion of the requirements for a showing of unavoidable delay. Specifically, an application is "unavoidably" abandoned only where petitioner, or counsel for petitioner, takes all action necessary for a proper response to the outstanding Office action, but through the intervention of unforeseen circumstances, such as failure of mail, telegraph, telefacsimile, or the negligence of otherwise reliable employees, the response is not timely received in the Office. Ex parte Pratt, 1887 Dec. Comm'r Pat. 31 (Comm'r Pat. 1887).

Petitioner alleges that an amendment was timely filed via facsimile transmission on August 5, 2004. Petitioner also alleges the fax was successfully transmitted and has provided a copy of a "Call Detail Page 2" (hereinafter "Call Detail") to support that the fax was transmitted to the Office. Additionally, petitioner submits a copy of the 9-page amendment with the instant petition.

While the amendment contains a certificate of facsimile transmission under 37 CFR 1.8 dated August 5, 2004 and the Call Detail shows a fax was sent to the USPTO on August 5, 2004, the Call Detail also shows that the fax was transmitted in 18 seconds. It is reasonable to conclude that a 9-page document cannot be transmitted in 18 seconds, which further shows the amendment was not successfully transmitted, as petitioner suggests. 37 CFR 1.8(b) in pertinent part states:

"In the event that correspondence is considered timely filed by being mailed or transmitted in accordance with paragraph (a) of this section, but not received in the Patent and Trademark Office, and the application is held to be abandoned or the proceeding dismissed, terminated, or decided with prejudice, the correspondence will be considered timely if the party who forwarded such correspondence...includes a statement which attests on a personal knowledge basis or to the satisfaction of the Director to the previous timely mailing or transmission. **If the correspondence was sent by facsimile transmission, a copy of the sending unit's report confirming transmission may be used to support this statement. ...The Office may require additional evidence to determine if the correspondence was timely filed.**" (Emphasis added)

Although petitioner has provided the Call Detail, it does not verify successful facsimile transmission of the amendment. A transmission confirmation report would be more suitable in this instance.

In view of the above, petitioner has not established that the delay in submitting a reply to the outstanding office action was unavoidable.

Moreover, a grantable petition under 37 CFR 1.137(b) must be accompanied by: (1) the required reply, unless previously filed; (2) the petition fee as set forth in 37 CFR 1.17(m); (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition

pursuant to 37 CFR 1.137(b) was unintentional; and (4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required by 37 CFR 1.137(d). The petition lacks item (1) as already stated. Again, the application will not be revived until a proper reply is received.


Since the petitions under 37 CFR 1.137(a) and 1.137(b) have both been considered by the Office, the petition fees of \$500 and \$1500, respectively, will be charged to petitioner's deposit account, as authorized.

Further correspondence with respect to this matter should be addressed as follows:

By Mail: Mail Stop PETITION
 Commissioner for Patents
 P. O. Box 1450
 Alexandria, VA 22313-1450

By hand: U. S. Patent and Trademark Office
 Customer Service Window, Mail Stop Petitions
 Randolph Building
 401 Dulany Street
 Alexandria, VA 22314

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3223.


Marianne E. Jenkins
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

Attachment: Examiner's Advisory Action

*2 months
from April 11*

Advisory Action
Before the Filing of an Appeal Brief

Application No. 09/582,796	Applicant(s) SEARLE ET AL.
Examiner Lloyd A. Gale	Art Unit 3676

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MAY 02 2005
U.S. PATENT & TRADEMARK OFFICE

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 08 December 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:
- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) a set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The reply was filed after the date of filing a Notice of Appeal, but prior to the date of filing an appeal brief. The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
- (a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ They raise the issue of new matter (see NOTE below);
- (c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
- The status of the claim(s) is (or will be) as follows:
- Claim(s) allowed: _____.
- Claim(s) objected to: _____.
- Claim(s) rejected: 62-67, 123-126, 128, 130-132, 134, 136.
- Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.
13. ☐ Other: _____.

Lloyd A. Gale
Lloyd A. Gale
Primary Examiner

Continuation of 3. NOTE: The amendments to claims 62 and 123 require further consideration.